

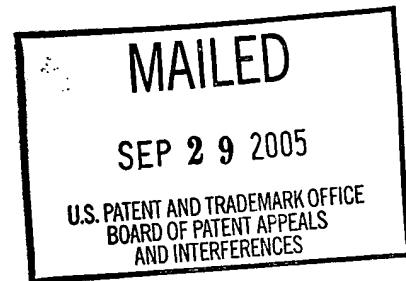
The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte TOMOHISA YAMAGUCHI

Appeal No. 2005-2107
Application No. 09/337,500



HEARD: SEPTEMBER 13, 2005

Before RUGGIERO, DIXON, and MACDONALD, **Administrative Patent Judges**.
DIXON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-16, 18 and 20, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

Appellant's invention relates to a system of dynamic module configuration and a method thereof. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below:

1. A system of dynamic module configuration which is linked through a network comprising:

 a memory, linked to the network, for storing a plurality of function executing modules which execute specific processes;

 a request device, located on said network remotely from said memory, which outputs an execution request for executing one of the specific processes; and

 an execution device, located on said network remotely from said memory and said request device, for receiving, through the network, the execution request output from the request device, acquiring, through the network, one of the plurality of function executing modules which has a function of realizing the execution request from the memory, executing the acquired function execution module and providing a result of the execution of the function execution module to the request device.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Tock	5,815,718	Sep. 29, 1998
Domenikos et al. (Domenikos)	5,838,910	Nov. 17, 1998
Kimishima	5,978,846	Nov. 02, 1999 (Filed Oct. 07, 1996)
Snyder et al. (Snyder)	6,161,167	Dec. 12, 2000 (Filed Mar. 31, 1995)
Tso et al. (Tso)	6,247,050	Jun. 12, 2001 (Filed Sep. 12, 1997)

Claims 1, 3, 5, 6, 11, 13, 15, 16, 18 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tock in view of Domenikos. Claims 2 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tock in view of Domenikos further in view of Snyder. Claims 4 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tock in view of Domenikos further in view of Tso. Claims 7-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tock in view of Domenikos further in view of Kimishima. Claim 10 stands rejected under 35 U.S.C. § 103 as being unpatentable over Tock in view of Domenikos further in view of Kimishima and Tso.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the answer (mailed Jun. 28, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed Apr. 16, 2004) and reply brief (filed Aug. 25, 2004) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellant has elected to group and argue the claims in two separate groupings. (Brief at page 6.) We select claims 1 and 15 as the representative claims and will address appellant's arguments thereto with respect to the combination of Tock and Domenikos.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a **prima facie** case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A **prima facie** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is **prima facie** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on Section 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or

Appeal No. 2005-2107
Application No. 09/337,500

hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See** **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. Am. Maize-Props. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), **citing In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-00, 50 USPQ2d at 1617, **citing McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations of independent claim 1. Independent claim 1 set forth three elements which are located remotely on a network.

A memory, linked to the network, for storing a plurality of function executing modules which execute specific processes; a request device, located on said network remotely from said memory, which outputs an execution request for executing one of the specific processes; and an execution device, located on said network remotely from said memory and said request device, for receiving, through the network, the execution request output from the request device, acquiring, through the network, one of the plurality of function executing modules which has a function of realizing the execution request from the memory, executing the acquired function execution module and providing a result of the execution of the function execution module to the request device.

The examiner maintains that Tock discloses the dynamic module configuration using a network, but does not teach the three elements remote from each other and that Domenikos teaches and suggests that the execution device, the memory and the request device are remote from each other and would have suggested such a configuration for the system. (Answer at pages 3-4.) We agree with the examiner and find that Domenikos teaches a distributed layout of the three elements. For example, Domenikos teaches at column 8 that the server 14 accesses external memory disk drive systems which we find to be remote from the server. Additionally, Domenikos discloses at column 8, lines 48-52, that the "server 14 is a standalone computer

system, however, the server can also be a networked computer system, having one or more data processors that can access local or networked memory devices.” We find this to be a further teaching and suggestion of a execution device and request device which is more “remote” from the memory device and the request device.

Appellant argues that Domenikos teaches a system in which two devices operate together. (Brief at page 9.) We disagree with appellant as discussed above. Appellant argues that Tock is exactly what the present invention has been designed to overcome and that the present invention alleviates the necessity to have a large memory and store large amounts of information within the device in connection with a request from a client. Appellant argues that, in contrast to Tock, appellant’s invention utilizes a device, i.e., a printer, scanner, etc. which has embedded therein an execution device, which performs server functions for obtaining and execution function modules. (Brief at page 10.) This argument is not persuasive since the argument is not commensurate in scope with the language of independent claim 1. We find no limitation which distinguishes over a traditional server or requires a smaller scale device to perform the execution functionality. Appellant argues that the execution device does not function like conventional servers. (Brief at page 10.) Again, we find no support for this argument and, this argument is not persuasive as discussed above.

Appellant argues that the remote memory stores all the necessary information to perform numerous tasks which reduces the necessity for memory within each of the

devices themselves allowing devices to be smaller and cheaper. This argument is not persuasive since we do not find it commensurate in scope with the invention recited in independent claim 1. Appellant argues that the system provides a greater number of execution modules which creates greater flexibility and abilities for the devices. (Brief at page 11.) This argument is not persuasive since we do not find it commensurate in scope with the invention recited in independent claim 1.

Appellant argues that the examiner's reliance upon Tock is in error since the acquiring and execution of the execution modules are not performed through the network and the memory and the function executing module are not remotely located. (Brief at page 13.) As discussed above, the examiner relies upon the teachings of Domenikos to teach and suggest that the three elements are remote. Therefore, this argument is not persuasive. Appellant argues that Domenikos only teaches the utilization of two separate devices: an agent/client 12 and a server 14. We disagree as discussed above. Appellant argues the examiner has not established a motivation for the combination of teachings and the combination does not teach or suggest every element of the claimed invention. (Brief at page 15 *et seq.*) We disagree with appellant and find that the examiner has set forth a motivation which is reasonable and appellant has not shown error therein. Therefore, this argument is not persuasive. Appellant argues that the examiner has not shown why it would have been obvious to one of ordinary skill in the art at the time of the invention to use a remote memory since both

Tock and Domenikos teach and suggest the use of memory with the server. (Reply brief at pages 1-3.) We disagree with appellant and find that Domenikos does expressly disclose and suggest the use of separate memory located on the network as discussed above. Additionally, we find that distributed storage was well known in the network environment to prevent duplication of files and programs. Since appellant has not adequately rebutted the examiner's **prima facie** case of obviousness, we will sustain the rejection of independent claim 1 and its dependent claims which appellant has elected to group together.

With respect to independent claim 15, appellant argues that the claim recites the integration of the request device in a device itself. Appellant argues that claim 15 requires the receiving, acquiring and executing are performed by using a part of the internal resource. (Brief at page 14.) The examiner maintains that Tock teaches the use of stored classes and instructions and these correspond to the internal resource that are used. We find no explicit definition in the specification of "an internal resource of a device" in claim 15 or an "operational device" in claim 18 nor has appellant identified one. Appellant similarly has not shown why the examiner's reliance upon these stored resources is in error with respect to the claimed invention. Therefore, this argument is not persuasive. Appellant argues that Tock and Domenikos only teach the

Appeal No. 2005-2107
Application No. 09/337,500

implementation of their system within a server and not a separate device, such as a printer, personal digital assistant (PDA), etc., and that the references fail to teach or suggest implementing such a system to be used in connection with various devices. (Brief at page 15.) We do not find that this argument is commensurate in scope with the language of independent claim 15. Therefore, this argument is not persuasive, as we find that appellant has not adequately rebutted examiner's **prima facie** case of obviousness.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-16, 18 and 20 under 35 U.S.C. § 103 is AFFIRMED.

Appeal No. 2005-2107
Application No. 09/337,500

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge


ALLEN R. MACDONALD
Administrative Patent Judge

Appeal No. 2005-2107
Application No. 09/337,500

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